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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,616	12/21/2001	Jerome Peyrelevade	05725.0983-00000	3938

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
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EXAMINER

HOLMES, MICHAEL B

ART UNIT	PAPER NUMBER
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2121

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/024,616	Applicant(s) PEYRELEVADE, JEROME	
	Examiner Michael B. Holmes	Art Unit 2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE (3) MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-91 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-91 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |



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Examiner's Detailed Office Action

1. This Office Action is responsive to communication received on October 03, 2006.
2. Amendment under 37 CFR § 1.111 reconsideration and allowance of application is respectfully requested by applicant.
3. Applicant's arguments have been fully considered, however, they are not persuasive. The rejection of April 03, 2006, under 35 USC § 102(a) stands. The complete text of which will not be included.
4. Moreover, the claims 36-55 & 56-68 are rejected under 35 USC § 101.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. The invention as disclosed in claims 36-55 & 56-68 are rejected under 35 U.S.C. § 101 as being non-statutory subject matter, as set forth in Interim Guidelines for Examination of Patent Applications for Subject Matter Eligibility. The claims are directed to an abstract idea rather than

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a practical application of an abstract idea which would produce a “useful, concrete or tangible results.” Moreover, the claims fails to provide a practical application and is insufficient to establish a real world “tangible” result.

7. The claims constitute a system of software modules devoid of any apparent hardware, and therefore are computer programs e.g., “functional descriptive material.” Moreover, since the computer programs are not embodied on an appropriate computer-readable storage medium. They are not patent eligible subject matter in accordance with *In re Warmerdam*, 31 USPQ2d, 1354. Furthermore, as mentioned above, the software modules as claimed does not produce any tangible result that has a practical application i.e., merely manipulating data not tied to the real-world is not patent eligible subject matter, *see In re Warmerdam*, 31 USPQ2d, 1354.

8. Devoid of such, applicant’s claimed invention is an abstract idea e.g., a computational model or a mathematical manipulation of a function or equation. A process that merely manipulates an abstract idea or performs a purely mathematical algorithm is non-statutory despite the fact that it might inherently have some usefulness. *see In re Sarkar*, 588 F.2d at 1335, 200 USPQ at 139, wherein the court explained why this approach must be followed:

No mathematical equation can be used, as a practical matter, without establishing and substituting values for the variables expressed therein. Substitution of values dictated by the formula has thus been viewed as a form of mathematical step. If the steps of gathering and substituting values were alone sufficient, every mathematical equation, formula, or algorithm having any practical use would be per se subject to patenting as a “process” under 101. Consideration of whether the substitution of specific values is enough to convert the disembodied ideas present in the formula into an embodiment of those ideas, or into an application of the formula, is foreclosed by the current state of the law.

9. A claim is limited to a practical application when the invention as claimed, produces a concrete, tangible and useful result; i.e., the invention recites a steps or a process or act of producing something that is concrete, tangible and useful. *See AT &T*, 172 F.3d at 1358, 50

USPQ2d at 1452. *See* MPEP § 2106(IV) The claimed invention as a whole must accomplish a practical application. That is, it must produce a “useful, concrete and tangible result.” *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. Remember, the claims define the property rights provided by a patent, and thus require careful scrutiny. Therefore, it is not enough to set forth invention in the specification. The claims must also reflect the scope and breath of applicant’s invention. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). The situation in this application appears to be more difficult since it does not appear that the practical application is contained within the specification.

Response to Argument(s)

10. The office action of the previous examiner stands as a testament to applicant’s arguments i.e., have been fully considered, however, they are not persuasive. Moreover, an artificial intelligence engine is simply a processor or a computer program that employs human intelligence e.g., speech recognition, deduction, inference, creative response i.e., the ability to learn from experience, and the ability to make inferences given incomplete information. Furthermore, artificial intelligence engines are well known.

Correspondence Information

11. Any inquires concerning this communication or earlier communications from the examiner should be directed to Michael B. Holmes, who may be reached Monday through

Friday, between 8:00 a.m. and 5:00 p.m. EST. or via telephone at (571) 272-3686 or facsimile transmission (571) 273-3686 or email michael.holmesb@uspto.gov.

If you need to send an Official facsimile transmission, please send it to (571) 273-8300.

If attempts to reach the examiner are unsuccessful the Examiner's Supervisor, Anthony Knight, may be reached at (571) 272-3687.

Hand-delivered responses should be delivered to the Receptionist @ (Customer Service Window Randolph Building 401 Dulany Street Alexandria, VA 22313), located on the first floor of the south side of the Randolph Building.

Finally, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Moreover, status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) toll-free @ 1-866-217-9197.

Michael B. Holmes

Patent Examiner

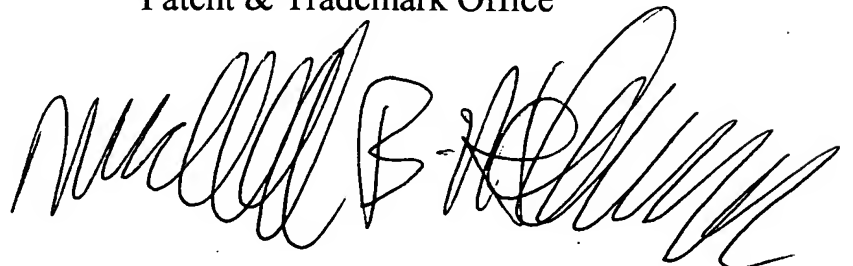
Artificial Intelligence

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United States Department of Commerce
Patent & Trademark Office

Thursday, March 1, 2007

MBH

A large, stylized handwritten signature in black ink, appearing to read 'Michael B. Holmes', is written over the typed name and title.